

**REMARKS**

This Application has been reviewed in light of the Office Action mailed February 2, 2005. All pending claims 1-45 were rejected in the Office Action. Claims 1 and 27 have been amended to further clarify the claimed subject matter. Applicants respectfully request reconsideration and allowance of all pending Claims 1-45

**Claim Objections**

The Examiner objects to Claim 27 because of certain informalities. Applicants have amended Claim 27 to address the informalities identified by the Examiner. Accordingly, Applicants respectfully request that the objection to Claim 27 be withdrawn.

**Section 102 Rejections**

The Examiner rejects Claims 1-4, 13-15, 17, 27, 36, 37, 41, and 42 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,157,829 issued to Goldman et al., ("*Goldman*"). For the following reasons, Applicants respectfully traverse the rejections of Claims 1-4, 13-15, 17, 27, 36, 37, 41, and 42.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); M.P.E.P § 2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); M.P.E.P § 2131 (*emphasis added*).

Claim 1, as amended recites the following limitations:

A system for playing a lottery-type game, comprising:  
a play generator operable to generate a playfile without input from any player of the game, the playfile having a plurality of records, each record comprising a numeric value;  
a win generator operable to generate a winning number; and

an evaluator operable to receive the playfile and the winning number, the evaluator operable to retrieve a record from the playfile in response to input from a player, to compare a numeric value in the retrieved record to the winning number, and to communicate a win/loss result to the player.

Independent Claims 13, 36, and 41 recite similar, although not identical, limitations.

Claim 1 is not anticipated by *Goldman* at least because *Goldman* does not disclose “a play generator operable to generate a playfile without input from any player of the game, the playfile having a plurality of records,” as recited by Claim 1. *Goldman* teaches a lottery game in which a player selects a desired number(s) to play by adjusting dials on a vending machine. *Column 3, lines 38-41*. Upon receipt of the player’s number, the machine generates a random number and determines whether the player’s selected number matches the randomly generated number. If so the player wins. *Column 3, line 57 – Column 4, line 9*.

This is unlike the invention of Claim 1 in which a playfile including a plurality of records is generated without any input from a player. One of these records is then later used by each player that plays the game. *Goldman* does not disclose the generation of a such a playfile. As described above, *Goldman* discloses that each player selects his own number to play at the time of playing the game. Thus, there is no disclosure of a playfile having a plurality of records since *Goldman* disclose that the number played by a player is created at the time of playing and thus there is not a playfile with multiple records. Furthermore, there is also no disclosure that such a playfile is generated without any input from a player since the players in *Goldman* generate their own number to play.

For at least this reason, Claim 1 is not anticipated by *Goldman*. Furthermore, Claims 13, 36, and 41 are also not anticipated by *Goldman* for similar reasons. Additionally, Claims 2-12, 14-27, 37-40, and 42-45 depend from Claims 1, 13, 36 and 41, respectively, and thus are also allowable over *Goldman* for at least this reason. Therefore, Applicants respectfully request reconsideration and allowance of Claims 1-27 and 36-45.

In addition to depending from an allowable independent claim, the dependent claims are also allowable based on further limitations of those claims not found in the cited art. As

an example only, Claims 4, 15, and 42 further recite that the playfile represents a number of plays at a win probability. The Examiner asserts that this limitation is disclosed at Column 4, lines 47-53 of *Goldman*. However, this passage simply describes that information is stored about winning players and about the bets that have been placed (amount and frequency). This is simply information about what has already happened. Again, there is no disclosure of a playfile as recited in the claims, much less a playfile that represents a number of plays at a win probability. Such a playfile thus can be used to control the outcome of the game since the records of the playfile are used by the players of the game. The system of *Goldman* cannot be so controlled since the players choose their own numbers. Furthermore, this seems to be recognized by the Examiner in his rejection of Claim 5. For at least these additional reasons, Claims 4, 15, and 42 are allowable over *Goldman*.

### **Section 103 Rejections**

The Examiner rejects several claims under 35 U.S.C. §103(a) as being unpatentable over a combination of references. The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103(a) (2000). Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations.

M.P.E.P. chs. 2142-43 (Rev. 2, May 2004). “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. ch. 2143.03 (Rev. 2, May 2004) (citations omitted).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant’s disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” M.P.E.P. ch. 2142 (Rev. 2, May 2004). The governing Federal Circuit cases are equally clear.

A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.”

*In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.PQ.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted).

In the present Office Action, Claim 5 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of U.S. Patent No. 5,551,692 issued to Pettit et al. (“*Pettit*”). First, there is no motivation to combine *Goldman* and *Pettit*. These references disclose two completely different systems and the Examiner provides no adequate reasoning as to how these references could be combined or what the motivation to combine would be. The Examiner suggests that motivation is the fact that one of ordinary skill would want to precisely control the occurrences of any prizes given out. However, this is in direct contravention to the operation of the system in *Goldman* in which the user is allowed to select his own number. If a “proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the

references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. §2143.01. There is simply no motivation to completely change the purpose and functionality of *Goldman* to control the occurrences of any prizes given out.

Furthermore, even if these references could be combined, the combination does not teach all the limitations of Claim 5. For example, neither *Goldman* nor *Pettit* disclose, teach, or suggest that a play generator generates a plurality of numeric values based on a number of plays and a win probability. As described above, and as recognized by the Examiner, *Goldman* does not teach this limitation. Furthermore, *Pettit* does not disclose this limitation. In the system disclosed in *Pettit*, the number that is assigned to the player to play is not taken from a playfile, but is instead randomly generated at the time of playing. The system then refers to a table to determine, based on an allowed number of wins for a number, to determine if the randomly generated number will result in a win or loss for the player. Therefore, the number that the player is assigned is not a record in a playfile, but is instead randomly generated. For at least this reason, Applicants respectfully request reconsideration and allowance of Claim 5.

Claims 10, 18, 38, and 43 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of U.S. Patent No. 6,609,116 issued to Lotspiech (“*Lotspiech*”), and further in view of U.S. Patent No. 6,636,892 issued to Philyaw (“*Philyaw*”). However, the cited passage from *Lotspiech* does not relate to decrypting a next record in a playfile using an extractor based on input from the player. *Lotspiech* discloses decrypting content, but there is no disclosure of a any file having a number of records, only the next of which is decrypted based on input from a user. For at least this reason, Applicants respectfully request reconsideration and allowance of Claims 10, 18, 38, and 43.

Claims 11, 19, 21, and 33-35 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of U.S. Patent No. 6,308,256 issued to Folmsbee (“*Folmsbee*”) and *Philyaw*. As discussed in the preceding paragraph, *Lotspiech* discloses decrypting content, but there is no disclosure of a any file having a number of records, only the next of which is decrypted based on input from a user. Furthermore, there is simply no disclosure in *Lotspiech* of using a key in a previous record in a file of multiple records to

decrypt the next record in the file. Furthermore, Claim 33 (and thus also dependent Claims 34 and 35) is also allowable for similar reasons as those described above in conjunction with Claim 5. For at least these reasons, Applicants respectfully request reconsideration and allowance of Claims 11, 19, 21, and 33-35.

Claims 12, 23, 40, and 45 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of *Folmsbee*, *Lotspiech*, *Philyaw*, and U.S. Patent No. 6,322,446 issued to Yacenda (“*Yacenda*”). Claims 28-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of U.S. Patent No. 5,830,064 issued to Bradish et al. (“*Bradish*”), U.S. Patent No. 5,197,736 issued to Backus et al. (“*Backus*”), *Folmsbee*, *Lotspiech*, *Philyaw*, and *Yacenda*. These claims contain similar limitations as discussed above in conjunction with Claims 11, 19, 21, and 33-35 and are allowable for at least the reasons given above. Furthermore, Claim 28 (and thus dependent Claims 29-32) contains limitations similar to those of Claim 1 and are allowable for similar reasons as discussed above in conjunction with Claim 1. Therefore, Applicants respectfully request reconsideration and allowance of Claims 12, 23, 28-32, 40, and 45.

Furthermore, Claims 6 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of *Bradish*. Claims 7 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of *Backus*, and in further view of *Bradish*. Claims 8, 9, and 26 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of *Backus*, and further in view of U.S. Patent No. 5,954,582 issued to Zach et al. (“*Zach*”). Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of U.S. Patent No. 5,096,195 issued to Gimmon (“*Gimmon*”). Claims 20, 39, and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of *Folmsbee*, *Lotspiech*, *Philyaw* and U.S. Patent No. 6,595,855 issued to Sako (“*Sako*”) and “The Authoritative Dictionary of IEEE Standards Terms, Seventh Edition”, (“*IEEE Dictionary*”). Claim 22 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of *Lotspiech*. Claim 32 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Goldman* in view of *Bradish*, *Backus*, *Folmsbee*, *Lotspiech*, *Philyaw*, and *Yacenda*, and further in view of *Gimmon*.

Each of these claims rejected in the preceding paragraph is at least allowable due to their dependence on an allowable independent Claim discussed above. Furthermore, these claims include additional novel and non-obvious limitations, which Applicants stand ready to discuss if appropriate. Therefore, Applicants respectfully request reconsideration and allowance of these claims.

**CONCLUSION**


Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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